

REMARKS

Status of the Application

Claims 1-6 are pending in this Application, as claims 5 and 6 are hereby added. Claims 1-4 stand rejected.

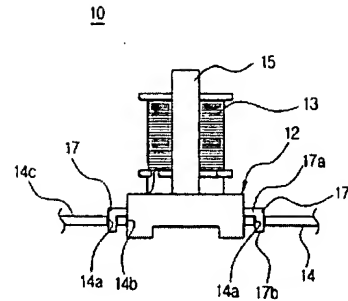
Claims 5 and 6 are identical to pending claims 3 and 4, but are dependent from claim 2 to provide a more varied scope of protection for the invention.

Indefiniteness Rejection

The Examiner has rejected claim 3 under 35 U.S.C. § 112, second paragraph, as allegedly being indefinite. The Examiner alleges that claim 3's recitation that "a radially inner face of the receiving hole and a radially outer face of the bobbin adjacent to the radially inner face of the receiving hole are perpendicular to the upper surface of the printed circuit board throughout a total thickness of the circuit board" is unclear. Applicant disagrees.

First, this rejection is improper on its face, as MPEP § 2173.02 clearly indicates that "if upon review of a claim in its entirety, the examiner concludes that a rejection under 35 U.S.C. 112, second paragraph, is appropriate, such a rejection should be made and an analysis as to why the phrase(s) used in the claim is 'vague and indefinite' should be included in the Office action." Here, there is no analysis of why the Examiner believes that one of ordinary skill in the art would find the recited features to be vague. Rather, the Examiner simply alleges that claim 3 is "unclear."

Second, Applicant respectfully submits that claim 3 clearly recites an arrangement of the invention, as exemplarily shown in FIG. 3, reproduced to the right for convenience. As shown in FIG. 3, a vertical wall of bobbin 12 and an adjacent vertical wall of the receiving hole 14b of printed circuit board 14 are both arranged in a perpendicular manner to an upper surface of printed circuit board 14.



Thus, Applicant respectfully requests the withdrawal of this rejection.

Anticipation Rejection

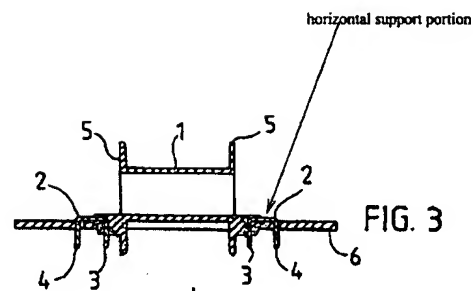
The Examiner has rejected: (1) claims 1, 2 and 4 under 35 U.S.C. § 102(e) as being anticipated by *Kataja* (US 2002/0057029 A1; hereinafter “*Kataja*”); and (2) claim 3 under 35 U.S.C. § 103(a) as being unpatentable over *Kataja* in view of *Chieng-heng* (US 5,165,056; hereinafter “*Chieng-heng*”). These rejections are respectfully traversed.

Independent Claim 1

Applicant respectfully submits that *Kataja* fails to teach or suggest, *inter alia*, “a horizontal support portion formed at the pins of the bobbin in parallel relation to an upper surface of the printed circuit board, for allowing the bobbin to be supported on the upper surface of the printed circuit board when the bobbin is inserted into the receiving hole,” as recited in independent claim 1.

The Examiner alleges that Figure 3 of *Kataja* shows this “horizontal support portion,” and provides a helpful modified version of that Figure to illustrate his position (reproduced to the right for convenience).

Applicant disagrees with the Examiner’s position.



Specifically, Applicant maintains that *Kataja* fails to teach or suggest that the portion of connector 2 cited by the Examiner provides any support whatsoever for frame part 1. Applicant respectfully submits that just because *Kataja*’s connectors 2 have portions that are parallel to the surface of circuit board 6 does not make these portions “support portions.” In fact, *Kataja* clearly discloses that the support of frame part 1 is provided by flange-like edges (see par. [0020]), not by connectors 2.

Thus, Applicant respectfully submits that independent claim 1 is patentable over the applied references. Further, Applicant respectfully submits that rejected dependent claims 3 and 4 are: (1) allowable *at least* by virtue of their dependency; and (2) separately patentable over the applied references (as discussed in the following sections).

Dependent Claim 3

Regarding the rejection of dependent claim 3, the Examiner concedes that *Kataja* fails to teach or suggest that the “radially inner face of the receiving hole and a radially outer face of the bobbin adjacent to the radially inner face of the receiving hole are perpendicular to the upper surface of the printed circuit board throughout a total thickness of the circuit board.”

However, the Examiner alleges that *Chieng-heng* discloses these features, and that it would have been obvious to modify *Kataja* to provide these features for the “purpose of securing the bobbin into [the] hole of the printed circuit board” (O.A., pg. 5).

However, Applicant respectfully submits that one of ordinary skill in the art at the time of the invention (“one of skill”) would not have modified *Kataja* in view of *Chieng-heng* as the Examiner alleges. Specifically, as discussed above, *Kataja* specifically discloses that the support of frame part 1 is provided by flange-like edges (see par. [0020]), not by connectors 2. If these flange-like edges were modified as the Examiner suggests, their supporting function would be eliminated and the frame part 1 would no longer be supported on circuit board 6.

In this regard, if frame part 1 were no longer supported on circuit board 6, *Kataja*’s system would no longer function. Thus, the proposed modification of *Kataja* is improper, as it has long been held that, if a “proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification.” *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984) *MPEP* § 2143.01

Dependent Claim 4

Regarding dependent claim 4, the Examiner alleges that *Kataja* “inherently discloses that the horizontal support portions [provide] support for the [weight] of the bobbin on the printed circuit board.” Applicant disagrees for the following reasons.

First, Applicant respectfully submits that the Examiner’s above position inaccurately represents the features of claim 4. Specifically, claim 4 recites that the “entire weight” of the bobbin is supported by the horizontal support portions.

Second, as discussed above, *Kataja* discloses that the support of frame part 1 is provided by flange-like edges (see par. [0020]), not by connectors 2 (either fully or partially).

Thus, Applicant respectfully request that the Examiner withdraw these rejections.

Conclusion

In view of the foregoing, it is respectfully submitted that claims 1-6 are allowable. Thus, it is respectfully submitted that the application now is in condition for allowance with all of the claims 1-6.

If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

Please charge any fees which may be required to maintain the pendency of this application, except for the Issue Fee, to our Deposit Account No. 19-4880.

Respectfully submitted,



Timothy P. Cremen
Registration No. 50,855

SUGHRUE MION, PLLC
Telephone: (202) 293-7060
Facsimile: (202) 293-7860

WASHINGTON OFFICE

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CUSTOMER NUMBER

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